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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,199	12/20/2001	Richard C. C. Chao	CHAO3014/EM	6075

7590

05/03/2004

BIRCH, STEWART, KOLASCH & BIRCH, LLP
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EXAMINER

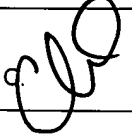
ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/022,199	Applicant(s) CHAO, RICHARD C. 	
	Examiner Kathryn Odland	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 5, 6 and 8-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This is a response to the amendment dated March 30, 2004. Claims 1-10 are pending. In view of the amendments, the 35 USC 112 rejections have been withdrawn. Further, the amendment presents non-generic claims drawn to alternate species. Thus, the following restriction has been applied.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1-2

Species II: Figure 4

Species III: Figure 5, 7, and 8

Valve Subspecies:

Subspecies a: Figures 3A-3B

Subspecies b: Figures 6A-6B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Robert Gnuse on April 23, 2004 a provisional election was made without traverse to prosecute the invention of Species 1 and Subspecies a, claims 1-5 and 7. Claims 6, 8, and 9 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. However, it appears that claim 5 is directed to the valve structure of Subspecies b (Figures 6A-6B). Thus, claim 5 has also been withdrawn from consideration.

Response to Arguments

3. Applicant's arguments with respect to claims 1-4 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim in US Re. 34,883.

Regarding claim 1, Grim discloses an apparatus having an inflation member (such as 10) including at least two pouches (such as 26) each of which have two free ends (as recited in column 4 and column 7, lines 65-68) with a slot opening formed therebetween, the pouches being not communicating with one another, as recited in column 4 and column 7, lines 65-68; a control means (28) mounted to each pouch; a delivery means (via that at 34) having one end connecting to the control means (28); and a single fluid generation means (30) connected to another end of the delivery means (via that at 34 and 134); wherein the fluid generation means (30) generates fluid and delivers the fluid through the delivery means into a pouch of the inflation member for inflating the pouch, as recited in columns 4-8, with emphasis on column 4, lines 29-45, column 6, lines 39-55 and seen in figures 1-15.

Regarding claim 2, Grim discloses that as applied to claim 1, as well as, free ends that are respectively attached by a fasten element (such as 70, etc), the fasten element being selected from the group consisting of Velcro strips, adhesive tapes, buttons, or zippers, as recited in column 5 and seen in figures 1-15.

Regarding claim 3, Grim discloses that as applied to claim 1, as well as, a control means (28) that is a check valve located between the delivery means (via the tube 34/134) and the fluid generation means (30). Grim discloses that the valves (28) are one-way valves. The 1192 ASHRAE Handbook has been cited which defines a check valve as valves that prevent reversal of flow.

Regarding claim 7, Grim discloses that as applied to claim 1, as well as, fluid generation means (30) that is a pliable gas inflation bulb that is inflatable and deflatable, as recited in column 4.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grim in US Re. 34,883 in view of Crowley in US Patent No. 4,653,550.

Regarding claims 4 and 5, Grim discloses that as applied to claim 1, as well as, control means that includes an inlet and an outlet. However, Grim does not explicitly recite a valve stem and an elastic element, the valve stem having one end attached to a rod. Grim does not disclose the specifics of the valve structure. On the other hand, a valve stem and an elastic element where the valve stem has one end attached to a rod is a known valve structure. Crowley teaches a valve stem (34 with 36) and an elastic element (42) where the valve stem (34 and 36) has one end attached to a rod (36), as recited in column 2 and seen in figures 1-4. Thus, it would be obvious to one with ordinary skill in the art to assure the system of Grim have a valve with a structure including a valve stem and an elastic element where the valve stem has one end attached to the rod, as taught by Crowley for the purpose of proper flow control.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO


Henry A Bennett
Supervisory Patent Examiner
Group 3700